REMARKS

Claim 16 has been canceled. Claims 1 and 21 have been amended to incorporate the limitations from dependent claim 16. Accordingly, no new matter has been added as a result of this amendment. Claims 1-14 and 17-21 are pending.

35 U.S.C. § 103 Claim Rejections

Wu et al. (US 5,851,937)

Claims 1-3, 5-6, 8-9, and 16-21 were rejected as being unpatentable over Wu et al. (US 5,851,937).

With respect to claims 1, 5, 6, and 21, the Examiner contends that Wu teaches a film comprising polycaprolactone blended with polyvinyl alcohol (PVA) and that Wu's composite can be incrementally stretched to create a film with micropores or microvoids for increased breathability. The Examiner relies on Applicant's disclosure (p. 6) to equate the polyvinyl alcohol of Wu as an example of a water soluble polymer. With respect to claims 1-3 and 19, the Examiner admits that the '937 patent does not explicitly disclose the claimed water vapor transmission rates (WVTR), but asserts that the WVTRs are result effective variables involving routine skill in the art and that there would have been a motivation to stretch the film in accordance with the WVTRs of the claimed invention. With respect to claims 8, 9, 19 and 20, the Examiner admits that Wu does not explicitly teach the limitations described therein, but asserts that stretching the film from 100-500 percent of its original length (cl. 19) or having an elongation break of greater than about 100% (cl. 8), greater than about 200% (cl. 9) or greater than about 350% (cl. 20) are either inherent (cl. 8, 9, 20) or represent a result effective variable involving routine skill in the art (cl. 19), further contending there would have been a motivation to stretch the film in accordance with the stretching and/or elongation break limitations of the claimed invention.

To support a prima facie case for obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicant's claimed invention recites a monolayer stretched precursor film. In

contrast, the '937 patent discloses a stretched composite comprising a laminate of one or more plies of a biodegradable and/or compostable film polymer (including a film containing a blend of an alkanoyl polymer and polyvinyl alcohol), and one or more plies of a biodegradable and/or compostable nonwoven web, preferably a polylactide nonwoven (PLA). Following extrusion lamination, the *laminate* is incrementally stretched across its length, width and depth to produce a soft cloth-like feel (see *e.g.*, col. 2, line 16-29; col. 3, line 37-col. 4, line 7; and col. 6, lines 56-63). Since the '937 patent does not disclose or suggest a stretched *monolayer precursor film*, the '937 patent does not disclose or suggest Applicant's claimed invention.

Additionally, the Examiner fails to provide a prima facie basis for Wu disclosing or suggesting a water vapor transmission rate (WVTR) of greater than 2500 g/m^2/24 hours. Instead, the Examiner merely asserts that WVTRs constitute a result effective variable and that it would have been obvious to one having ordinary skill in the art at the time the invention was made to stretch the film to a certain level to create a film with a WVTR greater than 2500 g/m^2/24 hours.

The polycaprolactone/PVA blended film in the stretched composite of the '937 patent is only described with reference to a blended film previously disclosed in U.S. Patent No. 5,200,247. Notwithstanding the nondisclosure of a *stretched monolayer precursor film* in the '937 patent having the limitations of the claimed invention, neither the '937 or the '247 patent provide a basis to suggest that any of Wu's stretched films would necessarily (or inherently) possess a WVTR of greater than 2500 g/m^2/24 hours. This is especially true of the '937 which only discloses stretching of a composite, rather than a precursor film.

Because Wu's composites are predicated on being impermeable to water, so as to function as a water barrier backsheet for diapers and pads (see *e.g.*, '937 patent, col. 6, lines 7-11; '247 patent, col. 2, lines 43-45; col. 2, lines 52-54; col. 7, lines 14-17; col. 10, lines 35-42; and col. 11, lines 15-23), it is unlikely that a skilled artisan would have been inclined to (or necessarily able to) stretch (or weaken) the composite structure disclosed in the '937 patent or the film disclosed in the '247 patent using the incremental stretching methodology of Wu in accordance with the high WVTRs of the claimed

invention, since this would appear contrary to Wu's explicit objective of retaining water impermeability.

Furthermore, it is unclear whether the incremental stretching techniques disclosed in the '937 and '247 patents would even be *able* to produce a WVTR of greater than 2500 g/m^2/24 hours. Precursor films of the present invention are contacted with a solvent resulting in dramatically enhanced WVTRs. Absent any disclosure of treating the water soluble polymer in conjunction with the stretching, there is nothing to suggest that incremental stretching of the Wu composites would be able to produce a stretched film having dramatically enhanced WVTRs of greater than 2500 g/m^2/24 hours, particularly since treatment with a solvent changes the dynamics and characteristics of the precursor film resulting from the stretching process.

With respect to the rejection against claim 19, the Examiner admits that Wu does not explicitly teach the limitations described therein, but has held that stretching the film from 100-500 percent of its original length represents a result effective variable involving routine skill in the art (cl. 19) and that there would have been a motivation to stretch the film in accordance with the stretching limitations of claim 19. Applicants traverse this rejection for reasons analogous to those relating to Wu not disclosing or suggesting the high WVTRs of the claimed invention. Specifically, because the claimed limitations apply to a stretched precursor film, one cannot reasonably conclude that the incremental stretching methodology disclosed by Wu, if applied to the *composites* of the '937 patent would inherently produce a stretched *composite* having a precursor film stretched between about 100-500% of its original length, given the differences in Wu's stretching methodology and given Wu's stated goal of producing a water impermeable composite.

With respect to the rejection against claims 8, 9, and 20, the Examiner admits that the '937 patent does not explicitly teach the limitations described therein, but has held that the recited elongation break limitations of greater than about 100% (cl. 8), greater than about 200% (cl. 9) or greater than about 350% (cl. 20) are inherent and that it is Applicant's burden to prove otherwise.

Applicants traverse the rejection against claims 8, 9, and 20, again for reasons analogous to those directed to Wu not disclosing or suggesting the high WVTRs of the claimed invention. Specifically, because the claimed limitations apply to a stretched precursor film, one cannot reasonably conclude that the incremental stretching methodology disclosed by Wu, if applied to the *composites* of the '937 patent would inherently produce a stretched *composite* having a *precursor film* with the elongation break characteristics of the claimed invention, given Wu's stated goal of producing a water impermeable composite, and given the differences in Wu's stretching methodology.

The Examiner is further reminded of the Office's position regarding rejections similarly applied to claims reciting stretching and elongation break limitations over Kroll et al. (US 6,432,547) in a related application, U.S. Pat. Appl. No. 09/840,754, now U.S. Pat. No. 6,905,759. In response to an Appeal Brief, dated November 3, 2004, the Office withdrew the pending rejections and allowed the pending claims, concluding that the closest prior art does not teach or suggest the recited stretched film having the recited stretching and elongation break limitations, and that the prior art does not provide motivation or suggestion for modifying the prior art to make the invention as instantly claimed.

In view of Applicant's arguments, Applicants respectfully request withdrawal of this rejection.

Wu et al. (US 5,200,247)

Claims 1-3, 5-6, 8-14, and 17-21 were rejected as being unpatentable over Wu et al. (US 5,200,247).

Applicant's claimed invention recites personal care product comprising a biodegradable film having a water vapor transmission rate of greater than about 2500 $g/m^2/24$ hrs that is laminated to a nonwoven web. Wu et al. does not disclose a personal care product having these limitations and the Examiner's rejection was not applied to previous claim 16, which is equivalent in scope to presently amended claim 1.

The '247 patent of Wu discloses a biodegradable film, including one comprising a blend of an alkanoyl polymer and a polyvinyl alcohol polymer. The Examiner applied similar reasoning to reject the previous independent and dependent claims 1-3, 5-6, 8-14, and 17-21 of the present invention over the '247 patent essentially for the reasons set forth in the rejection over the '937 patent above.

Like the '937 patent above, Wu's '247 patent similarly stresses the importance of the film being impermeable to water (see e.g., col. 2, lines 43-45; col. 2, lines 52-54; col. 7, lines 14-17; col. 10, lines 35-42; and col. 11, lines 15-23). Accordingly, Applicant's traverse the rejection for essentially the same reasons set forth in the rejection over the '937 patent with respect to the high WVTRs recited in the claimed invention (*i.e.*, greater than 2500 $g/m^2/24$ hours).

With Wu's '247 patent, the skilled artisan would not be inclined to stretch (or weaken) the blended film in accordance with the high WVTRs of the claimed invention, because this would reduce water impermeability of the composite. Moreover, in view of the importance in maintaining water impermeability according to the '247 patent, there is no reasonable expectation that a skilled artisan would be able to obtain WVTR of greater than 2500 $g/m^2/24$ hours using the incremental stretching methodology disclosed therein. And even if it were possible to obtain such high WVTRs, there is no reasonable expectation that Wu's stretched composite would be able to retain water impermeability characteristics in accordance with Wu's explicitly stated objectives as previously set forth above.

In view of Applicant's amendment and the arguments presented, Applicants respectfully request withdrawal of this rejection.

Kroll et al. (US 6,432,547) in view of Tsai et al. (US 6,838,403)

Claims 1-14 and 16-21 were rejected as being unpatentable over Kroll et al. (US 6,432,547) in view of Tsai et al. (US 6,838,403).

In accordance with 35 U.S.C. 103(c), subject matter qualifying as prior art under 35 U.S.C. 103 via 35 U.S.C. 102(e), (f), or (g) is not prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention

was made, owned by the same person or subject to an obligation of assignment to the same person." Accordingly, Applicants respectfully traverse this rejection in view of the fact that the present invention and Tsai et al. (US 6,838,403) were, at the time the invention of the present application was made, owned by or subject to an obligation of assignment to Kimberly Clark Worldwide, Inc. As evidence of such common ownership, the Examiner is directed to the face of the '403 patent listing Kimberly-Clark Worldwide, Inc. as the assignee. The Examiner is further directed to Reel 011736, Frame 0153, recording the assignment of the present invention to Kimberly-Clark Worldwide, Inc. Since the Tsai patent and the present invention were both under an obligation of assignment to Kimberly-Clark Worldwide, Inc., and since the present application was filed after November 29, 1999, the Wang patent does not qualify as prior art under 35 U.S.C. § 103(c) against claims 1-14 and 16-21.

Kroll et al. (US 6,432,547) in view of Noda et al. (US 6,808,795)

Claims 1-14 and 17-21 were rejected as being unpatentable over Kroll et al. (US 6,432,547) in view of Noda et al. (US 6,808,795).

Applicant's claimed invention recites personal care product comprising a biodegradable film having a water vapor transmission rate of greater than about 2500 $g/m^2/24$ hrs that is laminated to a nonwoven web. Neither Kroll nor Noda disclose a personal care product having these limitations. Moreover, the Examiner's rejection was not applied to previous claim 16, which is equivalent in scope to presently amended claim 1.

Given the insufficient evidence to support a prima facie case of obviousness, Applicants respectfully request that all pending rejections be withdrawn. It is believed that this application is now in condition for allowance. Such action is respectfully requested. If, for any reason, the Examiner is unable to allow the application in the next Office Action, Applicants respectfully request an interview with the undersigned attorney or agent to discuss any outstanding issues.

Respectfully submitted,

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